APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,571	12/09/2003	David L. Henrickson	317071.01	5084

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MICROSOFT CORPORATION
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EXAMINER
MANSFIELD, THOMAS L

ART UNIT	PAPER NUMBER
3624	

NOTIFICATION DATE	DELIVERY MODE
11/12/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>24 August 2010</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-6,8,10 and 11</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-6, 8, 10, and 11</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some * c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____.

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail. Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This Final Office action is in reply to the applicant amendment filed on 24 August

2010.

2.   Claims 1-6, 8, 10, and 11 have been amended.

3.   Claim 7 has been cancelled.

4.   Claims 1-6, 8, 10, and 11 are currently pending and have been examined.

Response to Amendment

5.   In the previous office action, Claims 1-8, 10, and 11 were rejected under 35

U.S.C. 101 because the claimed invention was directed to non-statutory subject

matter. Applicants' amendment has provided statutory support for Claims 1-6, 8,

10, and 11 and the rejection **is withdrawn**. Claim 7 has been cancelled and the

rejection **is moot** for this claim.

Response to Arguments

6.   Applicants' arguments filed 24 August 2010 have been fully considered but they

are not persuasive.

7.   Applicants submits that Harrisville-Wolff et al. (Wolff) (U.S. Pub. No.

2003/0041130) in view of Selitrennikoff et al. (Selitrennikoff) (U.S. 6,301,612)

does not teach or suggest in amended Claim 1: (1) *predicting, based on the*

inventory, other hardware or other software that is potentially of interest to the user [see Remarks page 8, second paragraph]; (2) presenting, to the user by the source computer, options for the new computer, wherein the options include pricing and available configurations of the new computer and available upgrades relative to the source computer, wherein the available upgrades comprise the predicted other hardware or other software [see Remarks page 8, second paragraph].

With regard to arguments (1) and (2), the Examiner respectfully disagrees. Applicants' arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. However, Wolff in view of Selitrennikoff teaches predicting (that allow searching and filtering for patches that are suitable for specific bugs, applications, and OS; may operate to evaluate previously gathered customer system information **192** and services history data **196** to recommend services to client systems **104, 116**), based on the inventory, other hardware or other software that is potentially of interest to the user (system and application upgrades, distribution of services, such as patch analysis and installation, client training, software upgrade installation and recommendation, recommended patches database **284**) (see at least paragraphs 7, 20-33, and 41-45); presenting (the services provided are the most current or upgraded versions of the service), to the user by the source computer, options for the computer, wherein the

options include pricing (may be configured to track the quantity of service usage and then to invoice the client system operator based on such tracked use or alternatively the invoicing may be a flat fee dictating the volume of service) *and available configurations of the computer and available upgrades relative to the source computer* (include ongoing or periodic monitoring of the client network to determine when patches and upgrades may be useful or required), *wherein the available upgrades comprise the predicted other hardware or other software* (allowing a client operator to initiate service requests, to be able to request and receive services managed or controlled by the service manager **240**, software upgrade installation and recommendation, recommended patches database **284**, service deployment mechanism **256**) (see at least paragraphs 37-45 and 59-51).

Claim Objections

8.   Claim 1 is objected to because of the following informalities: Claim 1 recites the phrase limitations, "...*of various of the components*" and, "...*of various of the presented*...". For proper sentence structure and examination purposes, the Examiner will interpret these phrase limitations as reciting, "...*of various components*..." and, "...*of various presented*...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "*the vendor*". There is insufficient antecedent basis for this limitation in the claim. For examination purposes, the Examiner will interpret "*the vendor*" as "*a vendor*". Appropriate correction is required.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 1-6, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrisville-Wolff et al. (Wolff) (U.S. Pub. No. 2003/0041130) in view of Selitrennikoff et al. (Selitrennikoff) (U.S. 6,301,612).

With regard to Claim 1, Wolff teaches *a computer acquisition method comprising:*

surveying (evaluate), *by a source computer* client system **104**, **116**, end user device), *components of the source computer, wherein the surveying results in an inventory of the components, wherein the inventory identifies hardware and software installed on the source computer, and wherein the inventory further identifies user state and user settings and user preferences of the source computer* (assisting an operator of a client device in analyzing their systems and selecting from available patches and upgrades, hardware analysis, analyzing the client system information to select operating system and application upgrades) (see at paragraphs 7, 27-37, 44, and claim 13);

receiving, from a user of the source computer a selection of various components identified in the inventory (available patches and upgrades, hardware analysis, analyzing the client system information to select operating system and application upgrades), system and application upgrades, distribution of services, such as patch analysis and installation, client training, software upgrade installation and recommendation) (see at least paragraphs 7, 20-33, 44, and claim 13);

packing, by the source computer, the user-selected components (the master server functions to distribute and install updated application packages) *except any user-selected hardware components into a migration file* (software upgrade installation and recommendation, allow efficient, automatic service provision to a client server, the services may be transferred within the service

provider system **100** as Java objects using the RMI protocol) (see at least paragraphs 45-49) (see at least paragraphs 5-7, 20-33);

predicting (that allow searching and filtering for patches that are suitable for specific bugs, applications, and OS)*, based on the inventory, other hardware or other software that is potentially of interest to the user* (system and application upgrades, distribution of services, such as patch analysis and installation, client training, software upgrade installation and recommendation, recommended patches database **284**, may operate to evaluate previously gathered customer system information **192** and services history data **196** to recommend services to client systems **104, 116**) (see at least paragraphs 7, 20-33, and 41-45);

presenting (the services provided are the most current or upgraded versions of the service)*, to the user by the source computer, options for the computer, wherein the options include pricing* (may be configured to track the quantity of service usage and then to invoice the client system operator based on such tracked use or alternatively the invoicing may be a flat fee dictating the volume of service) *and available configurations of the computer and available upgrades relative to the source computer* (include ongoing or periodic monitoring of the client network to determine when patches and upgrades may be useful or required)*, wherein the available upgrades comprise the predicted other hardware or other software* (allowing a client operator to initiate service requests, to be able to request and receive services managed or controlled by the service manager **240**, software upgrade installation and recommendation, recommended patches

database **284,** service deployment mechanism **256**) (see at least paragraphs 37-45 and 59-51);

receiving, from the user by the source computer, a selection of various presented options (allowing a client operator to initiate service requests, to be able to request and receive services managed or controlled by the service manager **240**, software upgrade installation and recommendation, recommended patches database **284,** service deployment mechanism **256**, may operate to evaluate previously gathered customer system information **192** and services history data **196** to recommend services to client systems **104**, **116**) (see at least paragraphs 37-45);

providing, by the source computer (client systems **104**, **116**; service provider system **100**), information to a vendor (service manager **160**), wherein the information comprises the inventory and the migration file and the selection of the various presented options, and wherein the information is configured to enable the vendor to migrate (service deployment mechanism **172**), from the migrations file, the various components identified in the inventory, the user state, the user settings, and the user preferences to the computer, and to install the various presented options selected by the user onto the computer (may be automatically installed) (see at least paragraphs 23-27 and 37-48).

Wolff does not specifically teach *a new computer*. Selitrennikoff teaches *a new computer* (a new computer or new or replacement hardware) in analogous art of computer replacement for the purposes of, "booting a client computer over a network" (see at least column 6, lines 6-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the establishing one computer as a replacement for another computer method as taught by Selitrennikoff with the service provider system of Wolff. One of ordinary skill in the art would have been motivated to do so for the benefit of compensating for a new computer or new or replacement hardware before the operating system boots on the client computer (Selitrennikoff, see at least 6, lines 6-56).

With regard to Claim 2, Wolff teaches *wherein the components comprise peripherals coupled to the source computer* (one or more user nodes each utilizing an operating system (OS) with user interfaces…and running applications and including installed patches; Java) (see at least paragraphs 24-27).

With regard to Claim 3, Wolff teaches *downloading a migration tool* (service proxies) *from the vendor onto the source computer, wherein the migration tool operating on the source computer performs at least the surveying* (software upgrade installation and recommendation, allow efficient, automatic service provision to a client server, the services may be transferred within the

service provider system **100** as Java objects using the RMI protocol) (see at least

paragraphs 45-49) (see at least paragraphs 5-7, 20-33) (see at least paragraphs

30-38).

With regard to Claim 4, Wolff teaches *wherein the migration tool is under*

the dominion of the vendor (service providers **136**, **148** are linked to the

communications network **132** to allow communications with the service manager

160 and direct communication with the client systems **104**, **116** when providing a

service) (see at least paragraph 27).

With regard to Claim 5, Wolff teaches: *loading a migration tool onto the*

source computer (Jini™ technology-enabled service, service proxies) *wherein the*

migration tool operating on the source computer performs at least the surveying

and wherein the migration tool is under the dominion of the vendor, and wherein

the upgrades are available from the vendor (see at least paragraphs 26-38).

With regard to Claim 6, Wolff teaches: *loading a migration tool onto the*

source computer (Jini™ technology-enabled service, service proxies, service

interface) *wherein the migration tool operating on the source computer performs*

at least the surveying and wherein the migration tool is under the dominion of the

vendor, and wherein the upgrades are available via an Internet link to an

instrumentality of a separate entity from the vendor (virtual service network, Internet, LAN, WAN) (see at least paragraphs 23-38).

With regard to Claim 8, Wolff teaches *loading a migration tool onto the source computer from a local storage medium comprising the migration tool* (storage **184**), *wherein the migration tool operating on the source computer performs at least the surveying* (see at least paragraphs 26-35).

With regard to Claim 10, Wolff teaches *activating, on the new computer by the user, at least one upgrade via a telecommunication link* (communications network **132**) (see at least paragraph 23).

With regard to Claim 11, Wolff teaches *wherein the upgrade comprises software* (received executable code) (see at least paragraph 24).

Conclusion

13.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed

within TWO MONTHS of the mailing date of this final action and the advisory
action is not mailed until after the end of the THREE-MONTH shortened statutory
period, then the shortened statutory period will expire on the date the advisory
action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be
calculated from the mailing date of the advisory action. In no event, however, will
the statutory period for reply expire later than SIX MONTHS from the mailing
date of this final action.

14.   The following prior art made of record and not relied upon is considered pertinent
        to applicant's disclosure:

        • Bozak et al. (U.S. 7,574,707) discloses an install-run-remove mechanism
          including remote installation of software resources onto a user's computer.

        Any inquiry concerning this communication or earlier communications from the
examiner should be directed to THOMAS MANSFIELD whose telephone number is
(571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-
6 pm, alt. Fridays.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Lynda Jasmin can be reached on 571-272-6782. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./
Examiner, Art Unit 3624

5 November 2010
Thomas Mansfield

/LYNDA C JASMIN/
Supervisory Patent Examiner, Art Unit 3624